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Applicant : Henry Wu
 App. No : 09/943,483
 Filed : August 29, 2001
 For : FOLDING CHAIR
 Examiner : Brian Green
 Art Unit : 3611

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

May 26, 2006

(Date)

Michael H. Trenholm, Reg. No. 37,743

Mail Stop Appeal Brief - Patents

Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Sir:

Transmitted herewith for filing in the above-identified application are the following enclosures:

- (X) Amended Appeal Brief in fourteen (14) pages in response to Notice of Non-Compliant Appeal Brief dated April 28, 2006
- (X) Evidence Appendix (including a copy of 1,847,605, 5,779,317, and 4,884,353)
- (X) Related Proceedings Appendix (including a copy of In re Gorman and In re Geiger).
- (X) Return prepaid postcard.

Docket No. : HENRYWU.007A
Application No. : 09/943,483
Filing Date : August 29, 2001

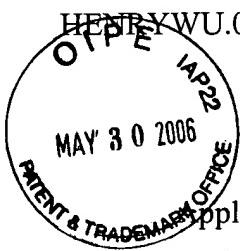
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No fees are believed to be due at this time. However, the Examiner is hereby authorized to charge any fees that may be due, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Dated: May 26, 2006


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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Henry Wu) Group Art Unit 3611
Appl. No. :	09/943,483)
Filed :	August 29, 2001)
For :	FOLDING CHAIR)
Examiner :	Brian Green)
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ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPELLANT'S BRIEF

**Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

Dear Sir:

Applicant, in the above-identified patent application, appeals the final rejection of Claims 7-9, 12, 13, 15-21, 32 and 33 which were rejected in the Final Office Action mailed May 10, 2005.

I. REAL PARTY IN INTEREST

The real party in interest is Henry Wu, the Applicant in the above-identified application.

Appl. No. : **09/943,483**
Filed : **August 29, 2001**

II. RELATED APPEALS AND INTERFERENCES

No appeals or interferences related to this case is currently pending.

III. STATUS OF CLAIMS

Claims 1-6, 10, 11, and 22-31 have been canceled. Claim 14 is objected to for depending from a rejected claim. Claims 7-9, 12, 13, 15-21, 32 and 33 are rejected and are being appealed.

IV. STATUS OF AMENDMENTS

No amendment has been filed since the Final Office Action mailed May 10, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed subject matter of the present invention generally relates to a folding chair having a padded sign, and is addressed by independent claims 7 and 15.

Claim 7 recites a folding chair (300, generally described in page 13, line 1 to page 15, line 8, in reference to Figures 6A, 6B, and 7) having a pair of spaced legs (402 and 404 in Figure 6A), a seat portion (424 in Figure 6A), and a back rest portion (316 in Figure 6A). The back rest portion (316) includes first and second edges (333a and 333b) disposed opposite each other. Claim 7 further recites a padded sign (312 in Figures 6A and 6B) having a main body (380 in Figures 6A and 6B) comprising a panel that defines a front surface and a rear surface. The main body (380) includes first and second edges (see Figures 6A and 6B) that are also disposed opposite each other. The padded sign (312) further includes at least one first retainer (see Figures 6A, 6B, and 7) that extends from the first edge of the main body (380) and has a hook shape (see Figures 6A, 6B, and 7) that is biased towards the rear surface of the main body (380) such that the at least one hook shaped first retainer can be urged over the first edge (333a) of the back rest portion (316) thereby retaining the first edge of the main body adjacent the first edge (333a) of the back rest portion (316) (see Figures 6A and 6B, and page 13, lines 3-5). The padded sign (312) further includes at least one second retainer (see Figures 6A, 6B, and 7) that extends from the second edge of the main body (380) and has a hook shape (see Figures 6A, 6B,

Appl. No. : 09/943,483
Filed : August 29, 2001

and 7) that is biased towards the rear surface of the main body (380) such that the at least one hook shaped second retainer can be urged over the second edge (333b) of the back rest portion (316). The first and second retainers are interconnected by the panel of the main body (380), and are formed from flexible material to allow installation and removal of the padded sign from the back rest portion of the folding chair. The padded sign further includes a padding (381 in Figure 6A) having an outer surface attached to the main body (380) wherein a message (see Figure 6A) is inscribed on the outer surface of the padding (381) so as to be positioned in front of the front surface of the main body (380).

Claim 15 recites a folding chair (300, generally described in page 13, line 1 to page 15, line 8, in reference to Figures 6A, 6B, and 7) having a folded and an unfolded configuration (see Figures 6A and 7). The folding chair (300) comprises a back rest portion (316 in Figure 6A) with an upper edge (333a) and a lower edge (333b). The folding chair (300) further includes a sign displaying device (312) having a main body (380) comprising a panel having an upper edge and a lower edge. The sign displaying device (312) further includes a plurality of retainers that extend from the upper and lower edges of the main body (380). Each of the plurality of retainers has a hook shape (see Figures 6A, 6B, and 7) that can be urged over its respective edge of the back rest portion (316) so as to allow securing of the main body (380) to the back rest portion (316). The plurality of retainers include at least one upper retainer that extends from the upper edge of the main body (380) and at least one lower retainer that extends from the lower edge of the main body (380). The at least one upper retainer and the at least one lower retainer are interconnected by the panel of the main body (380). The sign displaying device (312) further includes a padding (381) attached to the main body (380) such that the main body (380) is interposed between the padding (381) and the back rest portion (316) and such that the padding (381) defines a first surface where a message (see Figure 6A) is inscribed such that the message is visible when viewed from in front of the folding chair (300).

The folding chair as claimed in Claim 7 or 15 can have a message inscribed on the padded sign. Thus, the padded sign provides a functionality of a removable padding that can also provide a visual display such as advertising.

Appl. No. : 09/943,483
Filed : August 29, 2001

VI. GROUNDS OF REJECTION

The following rejections have been issued by the Examiner:

Claims 7-9, 12, 13, 15-21, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald (U.S. Patent No. 1,847,605 – “Fitzgerald”) in view of Neal (U.S. Patent No. 5,779,317 – “Neal”) and Taylor (U.S. Patent No. 4,884,353). Claims 7 and 15 are independent claims.

VII. ARGUMENT

The Examiner rejected independent claims 7 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Fitzgerald in view of Neal and Taylor. For reasons discussed below, Applicant respectfully submits that none of the cited references, individually or in any combination, teaches nor makes any suggestion to modify and/or combine various features to arrive at the unique combination as recited in claim 7. Also, for reasons discussed below, Applicant respectfully submits that none of the cited references, individually or in any combination, teaches nor makes any suggestion to modify and/or combine various features to arrive at the unique combination as recited in claim 15.

Fitzgerald

The Examiner relies on Figures 10 and 12 of Fitzgerald as the basis for the obviousness rejection. Upon review of Fitzgerald, Applicant notes that the only relevant feature of Fitzgerald appears to be the concept of securing a display sign on the back rest portion of a chair (as shown in Figure 12). The “FOR SALE” sign 24 is shown to be secured to the back rest 25 by a pair of springs (12 in Figure 10) having hooks 7 and 8.

The Examiner refers to the sign 24 as the main body panel. Applicant notes that in Fitzgerald, the sign 24 or the “main body panel” is not dimensioned to conform to the shape of the back rest 25. In fact, because of the nature of the spring-and-hooks assembly, it is preferable in Fitzgerald to have the sign 24 be wider (vertically) than the vertical dimension of the depicted back rest 25. To form a secure hooking of the hooks 7 and 8 over the edges of the sign 24, the spring 12 should preferably be stretched at least a little. However, if the sign 24 had a vertical

Appl. No. : 09/943,483
Filed : August 29, 2001

width similar to that of the back rest 25 (or the bumper 5 in Figure 3, or the lamp mounting rod 20 in Figure 4), the spring will likely not stretch sufficiently to provide the hooking action. Thus, Fitzgerald does not suggest at all the concept of the main body panel being dimensioned to conform to the shape of the back rest.

The Examiner also states that in Fitzgerald, the first and second retainers (hooks 7 and 8) extend from the first and second edges of the main body panel (sign 24). Applicant notes that this is not the case. The spring-and-hooks assembly is a completely separate structure from the main body panel (sign 24); and thus the hooks 7 and 8 cannot extend from the edges of the sign. The hooks 7 and 8 engage the edges, but they do not extend from the edges.

The Examiner also states that in Fitzgerald, the main body panel (sign 24) connects the first and second retainers (hooks 7 and 8). Applicant disagrees – the hooks 7 and 8 are interconnected by the spring 12, and not by the panel/sign 24. Again, the hooks 7 and 8 engage the edges of the panel/sign 24, but are not interconnected by panel/sign 24.

Based on the foregoing, Applicant respectfully submits that Fitzgerald in no way suggests any of the features of claim 7, other than perhaps the concept of securing a sign to the back rest portion of a chair. Similarly, Applicant respectfully submits that Fitzgerald in no way suggests any of the features of claim 15.

Neal

The Examiner relies on Figures 1-9 of Neal for the concepts of removably attaching a padded portion (30 in Figure 5) to a back rest portion (8 in Figure 1), and placing a message on the padded portion (Figures 7 and 9). The Examiner also relies on Neal for the concept of a folding chair having these two features.

Applicant notes that Neal emphasizes a particular method of providing the removable padded portion to the back rest portion and the seat portion. Specifically, great emphasis is placed on the concept of a raised locator area (item 5 for the seat back, and item 4 for the seat portion, in Figure 1) that allows alignment and cooperation of the corresponding attachment holes 12 on the padded parts (11 and 30 in Figures 2 and 5) and the attachment holes 7 on the seat back and the seat portion (Figure 1). Thus, Neal teaches a concept of precise matching of

Appl. No. : 09/943,483
Filed : August 29, 2001

the padded parts to the seat back and the seat portion by a combination of the raised locator and the matching attachment holes. Neal achieves such precision by providing generally unnatural protrusions on the seat back and the seat portion, as well as requiring use of multiple fasteners.

Applicant notes that Neal does *not* disclose or suggest any other method of attaching the padded portion to the back rest portion or the seat portion. In particular, Neal does not suggest the concept of hook-shaped retainers that extend from the main body of the padded sign. In fact, Neal may even discourage such a practice because the fit may not be precise enough.

Based on the foregoing, Applicant respectfully submits that Neal in no way suggests the combination of features recited in claim 7. Similarly, Applicant respectfully submits that Neal in no way suggests the combination of features recited in claim 15.

Taylor

The Examiner relies on Figures 1 and 3 of Taylor for the concepts of a sign holder (10 in Figure 1) having a padding (62 in Figures 2-4) and a sign panel (14 in Figure 1).

Applicant notes that Taylor teaches the concept of a front loading sign assembly. In particular, a fulcrum (60 in Figures 2, 6, and 9) is provided so as to allow a temporary deformation of the sign panel (14), thereby allowing a portion of the sign to be exposed for removal (Figures 4 and 9). The fulcrum 60 can be formed by the padding 62 (Figures 2-4). However, the padding 62 in Taylor is not contemplated for any form of comfort-based use.

Applicant further notes that the sign assembly of Taylor is not contemplated for use in a chair setting, no less in a folding chair setting. The Taylor sign assembly provides mounting holes 26 (Figures 2 and 6) "for the purpose of supporting the sign assembly 10 through the instrumentality of screws 27 fastened into a vertical sign support wall 28." (Column 3, lines 17-20).

Based on the foregoing, Applicant respectfully submits that Taylor in no way suggests the combination of features recited in claim 7. Similarly, Applicant respectfully submits that Taylor in no way suggests the combination of features recited in claim 15.

Appl. No. : 09/943,483
Filed : August 29, 2001

There is No Suggestion to Combine Fitzgerald, Neal, and Taylor

The Examiner stated in the Final Office Action (mailed May 10, 2005) that it would have been obvious to one of ordinary skill in the art to modify Fitzgerald in view of Neal and/or Taylor to arrive at various features as recited in claim 7 and claim 15. Applicant respectfully disagrees with such a conclusory statement. As discussed above, each cited reference at best discloses one or more features that are completely isolated from the combination of features of claims 7 and 15. None of the references even remotely suggests extending its disclosed concept to the desirability of the recited combination.

As discussed herein, Fitzgerald does not suggest at all the concept of the main body panel being dimensioned to conform to the shape of the back rest. Furthermore, Fitzgerald teaches use of completely separate spring-hooks based retainers that allow mounting to different sized mounting structures; and thus the hooks do not extend from the edges of the main body panel. Moreover, Fitzgerald does not teach or suggest retaining hooks that are interconnected by the main body panel, because the hooks are in fact connected by the springs to provide the intended functionality.

As also discussed herein, Neal teaches a concept of precise matching of the padded parts to the seat back and the seat portion by a combination of the raised locator and the matching attachment holes. Neal achieves such precision by providing generally unnatural protrusions on the seat back and the seat portion, as well as requiring use of multiple fasteners. Thus, Neal does *not* disclose or suggest the concept of hook-shaped retainers that extend from the main body of the padded sign.

As also discussed herein, Taylor does not teach or suggest use of its sign assembly in a chair setting, no less in a folding chair setting. The Taylor sign assembly is intended to be mounted to a support wall via screws. Taylor also does not teach the concept of hook-shaped retainers, or the concept of a padding on which visual signs can be inscribed.

Based on the foregoing, Applicant respectfully submits that there is no suggestion to combine Fitzgerald with Neal and/or Taylor. Applicant notes that the U.S. Court of Appeals for the Federal Circuit has ruled that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or

Appl. No. : 09/943,483
Filed : August 29, 2001

incentive supporting the combination." *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). In the present application, none of the prior art references provides the suggestion or incentive. Moreover, the Examiner has not provided any support for such suggestion or incentive.

Applicant further notes that the Federal Circuit has also ruled that failure of the Examiner to provide the necessary suggestion or motivation creates a presumption that references cited by the Examiner to support the obviousness rejection was based on hindsight. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). The Federal Circuit "forbids the use of hindsight in the selection of references that comprise the case of obviousness." *Id.*

Applicant further notes that even if Fitzgerald, Neal, and Taylor were to be combined in any manner, the resulting combination still would not yield all of the limitations as recited in claim 7. Similarly, even if Fitzgerald, Neal, and Taylor were to be combined in any manner, the resulting combination still would not yield all of the limitations as recited in claim 15. In a non-limiting example, hook-shaped retainers that extend from the main body panel of a padded sign constitute a feature that is not present in any combination of Fitzgerald, Neal, and Taylor.

Conclusion

In view of the foregoing, Applicant respectfully requests that the rejection of claims 7 be reversed. Furthermore, Applicant requests that the rejection of claim 15, and the dependent claims that depend on claims 7 and 15, also be reversed for at least the foregoing reasons.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 5/26/06

By: _____

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Appl. No. : 09/943,483
Filed : August 29, 2001

VIII. CLAIMS APPENDIX

The following claims are involved in the appeal:

Claims 1-6 (Canceled).

7. (Previously presented) A padded sign displaying apparatus, comprising:
 - a folding chair having a pair of spaced legs and a seat portion and a back rest portion that extends between the spaced legs wherein the back rest portion provides support for a person's back when sitting on the seat portion wherein the back rest portion includes a first edge and a second edge that is disposed opposite from the first edge; and
 - a padded sign comprising:
 - a main body having dimensions that conform to dimensions of the back rest portion such that the main body also includes a first edge and a second edge that is disposed generally opposite from the first edge of the main body, wherein the main body comprises a panel that defines a front surface and a rear surface;
 - at least one first retainer that extends from the first edge of the main body, wherein each of the at least one first retainer has a hook shape that is biased towards the rear surface of the main body such that the at least one hook shaped first retainer can be urged over the first edge of the back rest portion thereby retaining the first edge of the main body adjacent the first edge of the back rest portion;
 - at least one second retainer that extends from the second edge of the main body, wherein each of the at least one second retainer has a hook shape that is biased towards the rear surface of the main body such that the at least one hook shaped second retainer can be urged over the second edge of the back rest portion thereby retaining the second edge of the main body adjacent the second edge of the back rest portion, and wherein the at least one first retainer and the at least one second retainer are interconnected by the panel of the main body, such that the rear surface of the main body is positioned proximate the back rest portion of the chair and such that the front surface of the main body faces the person's back

Appl. No. : 09/943,483
Filed : August 29, 2001

when the person's back is supported by the back rest portion wherein the at least one first and second retainers are formed of a flexible material that allows the user to urge the at least one first and second retainers into and out of engagement of the first and second edges of the back rest portion to install and remove the padded sign from the chair; and

a padding having an outer surface attached to the main body wherein a message is inscribed on the outer surface of the padding so as to be positioned in front of the front surface of the main body.

8. (Previously presented) The apparatus of Claim 7, wherein the main body and the plurality of retainers are constructed of plastic, wherein the plurality of retainers form contiguous extensions from the main body.

9. (Previously presented) The apparatus of Claim 8, wherein the main body is a $\frac{1}{4}$ inch thick plastic.

10. (Canceled).

11. (Canceled).

12. (Previously presented) The apparatus of Claim 7, wherein the padded sign attached to the back rest portion of the folding chair is contoured to the back rest portion so as to retain the functional profile of the back rest portion.

13. (Previously presented) The apparatus of Claim 7, wherein the padding is attached to the main body by securing the padding onto the rear surface of the main body.

14. (Previously presented) The apparatus of Claim 13, wherein the padding is stapled to the rear surface of the main body.

15. (Previously presented) A folding chair having a folded and an unfolded configuration comprising:

a back rest portion with an upper edge and a lower edge wherein the back rest portion provides support for a person's back when sitting on the folding chair; and

a main body comprising a panel having an upper edge and a lower edge;

Appl. No. : 09/943,483
Filed : August 29, 2001

a plurality of retainers that extend from the upper and lower edges of the main body, wherein each of the plurality of retainers has a hook shape that can be urged over its respective edge of the back rest portion so as to allow securing of the main body to the back rest portion, wherein the plurality of retainers include at least one upper retainer that extends from the upper edge of the main body and at least one lower retainer that extends from the lower edge of the main body wherein the at least one upper retainer and the at least one lower retainer are interconnected by the panel of the main body, and wherein the at least one upper and lower retainers are formed of a flexible material that allows the user to urge the at least one upper and lower retainers into and out of engagement of the upper and lower edges of the back rest portion to install and remove the main body from the chair; and

a padding attached to the main body such that the main body is interposed between the padding and the back rest portion and such that the padding defines a first surface that comes into contact with the person's back when the person's back is supported by the back rest portion and wherein a message is inscribed on the first surface of the padding such that the message is visible when viewed from in front of the folding chair.

16. (Original) The folding chair of Claim 15, wherein the folding chair with the sign displaying device attached to the back rest portion has substantially similar dimensions as a folding chair without the sign displaying device attached.

17. (Original) The folding chair of Claim 16, wherein the folding chair with the sign displaying device attached to the back rest portion can be folded and unfolded without removing the sign displaying device.

18. (Previously presented) The folding chair of Claim 17, wherein a plurality of folding chairs with sign displaying devices attached can be stacked together when in the folded configuration.

Appl. No. : 09/943,483
Filed : August 29, 2001

19. (Original) The folding chair of Claim 15, wherein a user can sit on the unfolded folding chair and rest the user's back on the back rest portion of the folding chair with the sign displaying device attached to the back rest portion.

20. (Original) The folding chair of Claim 15, wherein the message displayed on the sign displaying device attached to the back rest portion enhances the appearance of the folding chair.

21. (Previously presented) The folding chair of claim 20, wherein a plurality of folding chairs with messages displayed on a plurality of sign displaying devices enhance an overall atmosphere of the gathering for which the folding chairs are being used.

Claims 22-31 (Canceled).

32. (Previously presented) The apparatus of Claim 7 wherein the first edge of the backrest portion and the first edge of the main body are oriented towards the top of the backrest portion and the second edge of the backrest portion and the second edge of the main body are oriented toward the bottom of the backrest portion.

33. (Previously presented) The folding chair of Claim 15, wherein the upper edge of the backrest portion and the upper edge of the main body are oriented towards the top of the backrest portion and the lower edge of the backrest portion and the lower edge of the main body are oriented towards the bottom of the backrest portion.

Appl. No. : **09/943,483**
Filed : **August 29, 2001**

IX. EVIDENCE APPENDIX

Attached hereto are copies of Fitzgerald (U.S. Patent No. 1,847,605), Neal (U.S. Patent No. 5,779,317), and Taylor (U.S. Patent No. 4,884,353) references.

The Fitzgerald reference was entered into the record by the Examiner in a Non-Final Office Action mailed August 26, 2004.

The Neal reference was entered into the record by the Examiner in a Final Office Action mailed April 27, 2004.

The Taylor reference was entered into the record by the Examiner in a Non-Final Office Action mailed August 26, 2004.

Appl. No. : 09/943,483
Filed : August 29, 2001

IX. RELATED PROCEEDINGS APPENDIX

Attached hereto are copies of *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) and *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). These two cases are cited in pages 7 and 8 of this brief, under the heading "There is No Suggestion to Combine Fitzgerald, Neal, and Taylor."

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than the impairment to Jonas and Beech that would be caused by allowing the case to remain in this Court. On balance, then, the Court concludes that the convenience of the parties would be served by transfer of this case to Kansas.¹

Moreover, transfer of this case would further the interest of justice. As noted above, the issues in this lawsuit are closely related to those of at least one other lawsuit that is pending before the Kansas court. Beech and EDO both base their cases in part on the *res judicata* effect of *EDO Corp.* The Kansas court is obviously better equipped than this Court to determine the effect of its prior ruling on the present dispute.² In addition, Beech alleges that its failure to assert its assignment claim as a counter-claim in *EDO Corp.* was based on EDO's failure to comply with an order of the Kansas court. As a matter of comity, the Court concludes that a determination whether an order was violated and, if so, whether such violation excuses any omissions on the part of either party, should be left to the Kansas court that issued the order.³ In addition, because the Kansas

Neither of the parties presented sufficient facts concerning their witnesses for the Court to determine how the convenience of witnesses would be affected by a change of venue. It appears to the Court that at least some of Beech's development work was done in Kansas, which suggests that venue in Kansas might be convenient for some witnesses. In contrast, there is no information before the Court from which it might infer that any witnesses are located in D.C. It also appears that some of EDO's development work was done in Utah, which suggests that a Kansas venue might not be less convenient than a D.C. venue.

This conclusion does not depend upon whether or not *EDO Corp.*, is still technically "pending" in Kansas.

The defendants present further arguments that transfer is not in the interest of justice. EDO suggests that the motion to transfer is a blatant act of forum shopping. Forum shopping is disfavored because it is a means to gain a more favorable result simply based on different choice of law rules. It is well established that manipulation of choice of law will not be allowed as a result of a change of venue motion. See *Schreiber v. Allis-Chalmers Corp.*, 448 F.Supp. 1079, 1083-85 (D. Kan. 1978), *rev'd on other grounds*, 611 F.2d 790 (10th Cir. 1979). This Court is confident that the Kansas court will not allow the outcome of this case to be manipulated by the transfer.

The commissioner argues that the public interest requires that this case be resolved. As far as this Court can discern, the Commissioner's "public interest" concerns are unaffected by a transfer of this case. Regardless of where this case is decided, it will be resolved.

court is already familiar with the complicated issues in this case, transfer would promote judicial economy. Accordingly, the Court concludes that the interests of justice and judicial economy are best served by a transfer of this case to the United States District Court for the District of Kansas.

III. Conclusion

[1] For the foregoing reasons, the Court holds that this case should be transferred to the Kansas district court pursuant to 28 U.S.C. §1404(a). This case could have been brought in Kansas. Therefore, a change of venue may be granted when it would further the convenience of the parties and witnesses, or the interests of justice. The Court concludes that the greater convenience to some parties of litigating in Kansas rather than D.C. outweighs any potential inconvenience to other parties caused by the transfer. Moreover, a proper resolution of this case depends on an interpretation of at least two orders by the United States District Court for the District of Kansas. Therefore, this Court concludes that it is in the interests of justice that this case be transferred to the Kansas court.

The Court will issue an Order of even date herewith in accordance with the foregoing Memorandum Opinion.

ORDER

In accordance with the Court's Memorandum Opinion of even date herewith, it is, by the Court, this 15 day of February, 1991:

ORDERED that plaintiffs' motion for a change of venue shall be, and hereby is, GRANTED; and it is

FURTHER ORDERED that this case shall be, and hereby is, transferred to the United States District Court for the District of Kansas pursuant to 28 U.S.C. §1404(a); and it is

FURTHER ORDERED that all other motions pending in this case shall be decided by the United States District Court for the District of Kansas.

Court of Appeals, Federal Circuit

In re Gorman

No. 90-1362

Decided May 13, 1991

PATENTS

1. Patentability/Validity — Obviousness —

Combining references (§115.0905)

Patent and Trademark Office's reliance on teachings of large number of references in

rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field.

2. Patentability/Validity — Construction of claims (§115.03)

Patentability/Validity — Obviousness — In general (§115.0901)

Claim which describes features of invention in great detail is nevertheless obvious in view of prior art, since claim that is narrowly and specifically drawn must still meet requirements of 35 USC 103, and details listed in claim are shown in references and thus do not contribute to unobviousness.

3. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Patentability/Validity — Obviousness — Combining references (§115.0905)

Application claim for candy sucker on stick, molded in elastomeric mold in shape of human thumb, is obvious in view of prior art, since all elements of claim, including molded lollipop having chewing gum base plug, with elastomeric mold serving as product wrapper, and candy in shape of human thumb, are shown in prior art references in various combinations, used in same manner and for same purpose as in claimed invention.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Jeffrey B. Gorman and Marilyn Katz, serial no. 06/882,480 (composite food product). From decision of Board of Patent Appeals and Interferences upholding examiner's rejection of all claims in application, applicants appeal. Affirmed.

Thomas W. Tolpin, Highland Park, Ill., for appellant.

Teddy S. Gron, associate solicitor (Fred E. McKelvey, solicitor, with him on brief), for appellee.

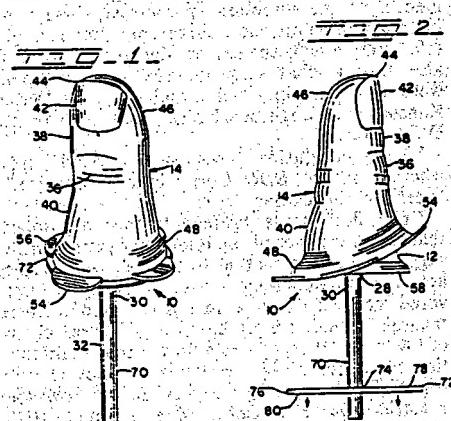
Before Rich, Newman, and Rader, circuit judges.

Newman, J. — The Board of Patent Appeals and Interferences ("Board") denied the appeal of Jeffrey B. Gorman and Marilyn Katz (hereinafter "Gorman") of the decision of the United States Patent and Trademark Office, Board of Patent Appeals and Interferences (the "Board"), denying patentability to all the claims of Gorman's patent application Serial No. 06/882,480, entitled "Composite Food Product." We affirm.

The Invention

The claimed invention is a composite candy sucker on a stick, molded in an elastomeric mold in the shape of a human thumb. During the manufacturing process, liquid candy is poured into the mold, and an edible plug of bubble or chewing gum or chocolate or food-grade wax is poured into the mold after the candy has hardened, serving as a seal for the end portion of the candy. A paper or plastic disc abuts and covers the plug. The mold serves as a cover that can be removed from the candy by means of protruding flanges. The cover is described as a "toy and novelty item".

Figure 1 shows the invention in the form in which it is marketed. Figure 2 shows the cover partially removed to reveal the candy portion (12) and the chewable or edible plug (58).



The claims describe the product in detail, as is apparent from claim 16, the claim pressed by Gorman in this appeal:

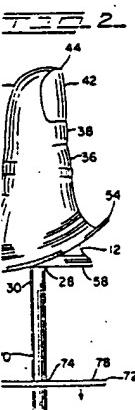
16. A composite food product, comprising:
a candy core, said candy core being in a generally liquified form when formulated,

heated, blended and in a substantially dened form when from said mold; said thumb-shaped portion comprising said candy vertical axis and shaped portion, tending upwardly shaped portion and a rigid lower portion wardly from said portion having a portion with an rigid top end of dened form and tending rearwardly from said rigid tip, an recessed opening receiving socket a a removable substantially the material selecting of rubber shell providing a mold for liquefied candy, a removable cation about an form comprising a toy and no upon the thumb from said hardened candy core; said thumb-shaped portion comprising said flexible upper layer from said flexible along said vertical axis lower portion of said flexible junction said vertical axis being a flexible with an upper flexible top end of convex back downwardly from said flexible enlarged open base having a transverse cross portions of said bottom of said defining a plug access opening fixed form and candy form, symmetrical ally outwardly

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heated, blended and poured into a mold and in a substantially thumb-shaped hardened form when cooled and removed from said mold;

said thumb-shaped hardened form comprising said candy core positioned along a vertical axis and comprising a rigid joint-shaped portion, a rigid upper portion extending upwardly from said rigid joint-shaped portion along said vertical axis, and a rigid lower portion extending downwardly from said rigid joint-shaped portion along said vertical axis, said upper portion having a rigid finger nail-shaped portion with an upper rigid tip providing a rigid top end of said thumb-shaped hardened form and a rigid convex back extending rearwardly and downwardly from said rigid tip, and said rigid lower portion having a rigid bottom end and defining a recessed opening comprising a handle-receiving socket about said vertical axis;

a removable resilient shell comprising a substantially thumb-shaped, elastomeric material selected from the group consisting of rubber and flexible plastic, said shell providing

a mold for receiving and molding said liquified candy form;

a removable outer protective cover positioned about and covering said hardened form comprising said candy core, and

a toy and novelty item for placement upon the thumb of the user when removed from said hardened form comprising said candy core;

said thumb-shaped elastomeric material comprising said removable resilient shell comprising a flexible joint-shaped portion, a flexible upper portion extending upwardly from said flexible joint-shaped portion along said vertical axis, and a flexible lower portion extending downwardly from said flexible joint-shaped portion along said vertical axis, said upper portion having a flexible finger nail-shaped portion with an upper flexible tip providing a flexible top end of said shell and a flexible convex back extending rearwardly and downwardly from said flexible tip, and said flexible lower portion having an enlarged open ended diverging base, said base having a larger circumference and transverse cross-sectional area than other portions of said shell and providing the bottom of said shell, said open ended base defining a plug-receiving chamber and an access opening for entrance of said liquified form and discharge of said hardened candy form; and a set of substantially symmetrical arcuate lobes extending radially outwardly from said base, said lobes

being circumferentially spaced from each other and providing manually grippable flange portions to facilitate manual removal of said shell from said core; a plug positioned in said plug-receiving chamber adjacent said bottom of said shell, said plug abutting against the bottom of said core and providing a cap for substantially plugging and sealing the open end of said mold and cover to help enclose said candy core, and said plug comprising a food grade material selected from the group consisting of bubble gum, chewing gum, chocolate, and food grade wax;

a handle having a connecting portion connected to said plug and said candy core and positioned in said plug-receiving opening and having a manually grippable handle portion extending downward from said connecting portion along said vertical axis; and

a substantially planar annular disk for abuttingly engaging and removably seating against said base and said lobes adjacent said plug, said disk defining a central axial hole for slidably receiving said handle portion and having an outer edge with a maximum span larger than said access opening but less than the maximum diameter of said symmetrical set of lobes to substantially minimize the interference with manually gripping of said manual grippable flange portions of said lobes, said disk being of a material selected from the group consisting of paper, paperboard, and plastic, and providing a removable closure member and seal for substantially closing said access opening and sealing said plug and said candy core within said shell.

The claims were rejected in view of thirteen references. The primary references, patents to Siciliano, Copeman, and Pooley, show ice cream or candy molded in a plastic, rubber or elastomeric mold. In Siciliano and Copeman the mold also serves as the product wrapper. In Siciliano the ice cream is poured into the mold, a stick is inserted, the ice cream is hardened, and a cardboard cover seals the area between the stick and the elastomeric wrapper. Copeman and Kuhlke show candy lollipops molded in elastomeric molds. Copeman states that the mold may take "varying shapes, such as in the form of fruit, or animals" and Kuhlke discusses the desirability of sealing candy from the outside air. In Siciliano, Copeman and Kuhlke, the mold is peeled from the confection prior to use.

The two Nolte patents teach that gripping flanges may be placed on an ice cream wrap-

per to facilitate removal. Ahern and Knaust each show a disc-shaped seal or cover for a frozen confection. Ahern shows the cover in conjunction with ice cream on a stick.

Harris shows a hollow thumb-shaped lollipop into which the thumb is inserted, and Craddock shows a thumb-shaped confection supported on a disc-shaped handle; in both cases without the other elements shown by Gorman. Fulkerson shows a candy coating surrounding a block of ice cream, and a candy plug for retaining liquid syrup inside a cavity in the ice cream. Webster shows chewing gum entirely enclosing a liquid syrup product. Spiegel shows a chocolate layer having an alcohol diffusion barrier to plug the end of a plastic container of liqueur. Fulkerson, Webster and Spiegel all suggest the greater appeal to consumers of providing two different components in the same confection.

The Board found that all of the features of Gorman's product were known to the art, and that various combinations of these elements existed in known similar structures. The Board concluded that the applicant's claimed combination was suggested by and would have been obvious in light of the references.

Discussion

Each element of the Gorman claims is in the prior art, separately or in sub-combination. Gorman argues that when it is necessary to combine the teachings of a large number of references in order to support a rejection for obviousness under 35 U.S.C. §103, this of itself weighs against a holding of obviousness.

[1]. The criterion, however, is not the number of references, but what they would have meant to a person of ordinary skill in the field of the invention. In *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383, 231 USPQ 81, 93 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987), the court held that a combination of about twenty references that "skirt[ed] all around" the claimed invention did not show obviousness. In other instances, on other facts, we have upheld reliance on a large number of references to show obviousness. Compare *In re Miller*, 159 F.2d 756, 758-58, 72 USPQ 512, 514-15 (CCPA 1947) (rejecting argument that the need for eight references for rejection supported patentability) with *Kansas Jack, Inc. v. Kuhn*, 719 F.2d 1144, 1149, 219 USPQ 857, 860 (Fed. Cir. 1983) (where teachings relied upon to show obviousness

were repeated in a number of references, the conclusion of obviousness was strengthened). See also, e.g., *In re Troel*, 274 F.2d 944, 947, 124 USPQ 502, 504 (CCPA 1960) (rejecting appellant's argument that combining a large number of references to show obviousness was "farfetched and illogical").

Determination of whether a new combination of known elements would have been obvious to one of ordinary skill depends on various facts, including whether the elements exist in "analogous art", that is, art that is reasonably pertinent to the problem with which the inventor is concerned. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986). When the references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed. *In re Ser-naker*, 702 F.2d 989, 994, 217 USPQ 1, 5 (Fed. Cir. 1983), and the test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention. See *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination." *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990) (quoting *Carrella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986)).

The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the applicant's invention. As in all determinations under 35 U.S.C. §103, the decisionmaker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. *Interconnect Planning*, 774 F.2d at 1143, 227 USPQ at 551. The references themselves must provide some teaching whereby the applicant's combination would have been obvious.

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Gorman argues that ice cream in a stick and the references to or wrapper on a stick they require differentiation. However, he claims the close relationship that his elastomer "frozen confections". We conclude that stick and candy on a stick and that the Sicilian Kuhlke references candy on a stick and a mold, for which was shown by Harris or

The suggestion chewing gum, chewing the candy covered by the mol provide a second for Fulker son, Webster disc adjacent the bar is shown in Ahern Craddock both she Gorman argues that suggest using the toy after the candy Copeman states that used as a "toy ball" removed. Gorman teaches away from because of Craddock pops on sticks are However, candy on for this caution unobviousness.

[2] Claim 16 re-
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The mere fact that all of the feature ("picture claim") is cation for the all Manual of Patent §706 (Rev. 6, Oct. Romito, 289 F.2d (CCPA 1961) (rej.) [3] Applying the *John Deere & Co.* USPQ 459, 467 (1961) elements of claim the same manner, i of endeavor. The

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Gorman argues that the references showing ice cream in a mold or wrapper on a stick and the references showing candy in a mold or wrapper on a stick are not analogous, for they require different conditions of production. However, the Copeman reference shows the close relationship of these arts, stating that his elastomeric mold may be used for "frozen confections and other solid confections". We conclude that the ice cream on a stick and candy on a stick arts are analogous, and that the Siciliano, Copeman, Pooler, and Kuhlke references show or suggest Gorman's candy on a stick and covered with an elastomeric mold, for which the thumb-shape is shown by Harris or Craddock.

The suggestion of providing a layer of chewing gum, chocolate or the like, surrounding the candy core in the area not covered by the mold, to seal the candy and provide a second food product, is provided by Fulkerson, Webster, or Spiegel. The paper disc adjacent the base of the candy structure is shown in Ahern and Knaust. Harris and Craddock both show thumb-shaped candy. Gorman argues that the prior art does not suggest using the thumb-shaped cover as a toy after the candy is removed. However, Copeman states that his rubber mold may be used as a "toy balloon" after the candy is removed. Gorman argues that Craddock teaches away from the claimed invention because of Craddock's admonition that lollipops on sticks are dangerous to children. However, candy on a stick is too well known for this caution to contribute to unobviousness.

[2] Claim 16 recites details such as a "joint-shaped portion", a "finger nail portion", an "upper portion", a "lower portion" and a "convex back", as descriptive of the thumb shape. Such details are shown in the references and do not contribute to unobviousness. A claim that is narrowly and specifically drawn must nevertheless meet the requirements of §103.

The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture claim") is never, in itself, justification for the allowance of such a claim. Manual of Patent Examining Procedure, §706 (Rev. 6, Oct. 1987) at p. 700-6; *In re Romito*, 289 F.2d 518, 129 USPQ 359 (CCPA 1961) (rejecting a "picture claim").

[3] Applying the principles of *Graham v. John Deere & Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), we discern all of the elements of claim 16 used in substantially the same manner, in devices in the same field of endeavor. The various elements Gorman

combined: the molded lollipop with a chewing gum plug, with the mold serving as the product wrapper; and candy in the shape of a thumb; are all shown in the cited references in various sub-combinations, used in the same way, for the same purpose as in the claimed invention. The Board did not, as Gorman argues, pick and choose among isolated and inapplicable disclosures in the prior art. Rather, the claim elements appear in the prior art in the same configurations, serving the same functions, to achieve the results suggested in prior art. *In re Sernaker*, 702 F.2d at 994, 217 USPQ at 5. The large number of cited references does not negate the obviousness of the combination, for the prior art uses the various elements for the same purposes as they are used by appellants, making the claimed invention as a whole obvious in terms of 35 U.S.C. §103.

The Board's decision is

AFFIRMED.

Court of Appeals, Federal Circuit

J & J Snack Foods Corp. v. McDonald's Corp.

No. 90-1394

Decided May 17, 1991

TRADEMARKS AND UNFAIR TRADE PRACTICES

1. Acquisition, assignment, and maintenance of marks — Acquisition through use — Priority of use (§305.0503)

Opposer's evidence showing extensive usage and promotion of various marks using "Mc" formative, in association with opposer's "McDonald's" mark in advertising and at its restaurants, is sufficient to establish that public associates opposer with family of marks using "Mc" formative; fact that opposer does not own trademark rights in formative alone does not require contrary result, since formative itself need not be trademark in order to sustain family of marks, nor does existence of third party registrations for various "Mc" names defeat opposer's rights in specific family of marks in which "Mc" prefix is used with generic food names to create fanciful words.

aminer, and the need under the facts of this case for a careful interpretation of those proceedings by one of ordinary skill in the art, explanatory testimony could aid the trial court (if it had doubt) in ascertaining the scope of the [claim].

Under the circumstances of this case, summary judgment should not have been granted.

3. "Uniform Outer Diameter"

MedComp continues to adhere to its interpretation of the phrase "uniform outer diameter" in claim 7 as an alternative basis for affirming the judgment below. MedComp contends that because this limitation was added during prosecution, Howes is estopped from claiming a catheter with a tapered distal tip, therefore its catheter does not infringe. The district court rejected this argument as a basis for granting summary judgment, holding instead that it was reasonable to include tapered catheters within the scope of claim 7.

If one thing is clear from the prosecution history of the patent, it is that Howes added the limitation of a uniform outer diameter at the distal end of the catheter tube only to distinguish the catheter in *Bielinski*, U.S. Patent No. 3,437,088, which had protuberances along its length. Some additional gloss was placed on this language by Howes' patent attorney in distinguishing the Cournand catheter during reissue, but Cournand was distinguished on a number of grounds. Significantly, the non-uniformity in the Cournand catheter body is not at its tip — it begins halfway along the length of the catheter body. At most, Howes' argument to the examiner can be taken, as surrendering from claim coverage a catheter with size changes along its insertion length, not at its tip.

C. Other Errors

It is a truism that this court reviews judgments, not opinions, see, e.g., *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 781, 218 USPQ 673, 677 (Fed. Cir. 1983), but the district court's July 22, 1985, summary judgment order contains several misstatements of law which should not be left without comment.

The district court in several places appears to confuse claim allowance with infringement of third-party patents, stating that "Howes was compelled to amend his patent application to avoid infringing prior art patents" and that the Howes patent was allowed because "small but significant differences

are enough to prevent infringement." In discussing the doctrine of equivalents, the court seems equally confused in its observation that although the differences between MedComp's catheter and Howes catheter were not great, "small changes have been enough to distinguish new catheters from prior art."

It is impossible to deduce whether these obvious misstatements contributed to the erroneous judgment below. Cf. *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984) ("language in an opinion . . . may indicate that harmful errors of law produced an erroneous conclusion"). They do, however betray a lack of familiarity with certain fundamentals of patent law which should be remedied on remand.

CONCLUSION

[1] We hold, therefore, that the district court erred as a matter of law in construing claim 7 as limited to Fig. 3 of the Howes patent based on its interpretation of the words "joined" and "freely" as contained therein. In doing so, the district court also failed to recognize genuine issues of material fact surrounding the reissue of the patent which make summary judgment inappropriate in this case. The judgment of non-infringement of claim 7 by MedComp and AHS is *vacated* and the case is *remanded* for further consideration consistent with this opinion.

VACATED AND REMANDED

Court of Appeals, Federal Circuit

In re Geiger*

No. 86-1103

Decided April 1, 1987

PATENTS

1. Patentability/validity — Obviousness — Evidence of (§115.0903)

Obviousness cannot be established by combining teachings of prior art to produce

* This opinion issued as an unpublished opinion on December 11, 1986. On request of counsel for appellant, it is now being reissued as a published opinion.

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claimed invention; combination; and the obvious-to-combine references to evidence of obviousness.

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claimed invention, absent some teaching, suggestion, or incentive supporting combination, and thus, although it might have been obvious to one skilled in art to try various combinations of teachings of three prior art references to achieve claimed method, such evidence does not establish *prima facie* case of obviousness.

Particular Patents — Corrosion inhibitor

Geiger, application No. 373,903, for method of inhibiting scale formation on and corrosion of metallic parts in cooling water systems, Claims 43-63, and 65-67, not obvious.

Appeal from United States Patent and Trademark Office, Board of Patent Appeals and Interferences.

Application for patent of Gary E. Geiger, application, Serial No. 373,903; from affirmation of rejection of claims, applicant appeals. Reversed; Newman, Circuit Judge, concurring with opinion.

Bruce E. Peacock, Trevose, Pa., for appellant.

Robert D. Edmonds, associate solicitor (Joseph F. Nakamura, solicitor, and Fred E. McKelvey, deputy solicitor with him on the brief), for appellee.

Before Skelton, Senior Circuit Judge, and Newman and Archer, Circuit Judges.

Archer, Circuit Judge.

This is an appeal from a decision of the United States Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences (board), Appeal No. 606-09, affirming the examiner's rejection of all remaining claims, 43-63 and 65-67, in appellant's patent application, Serial Number 373,903 ('903), under 35 U.S.C. §103. We reverse.

OPINION

Background

The '903 application, filed on May 3, 1982, is directed to a method of inhibiting

scale formation on and corrosion of metallic parts in cooling water systems by use of compositions containing (1) a sulfonated styrene/maleic anhydride (SSMA) copolymer, (2) a water soluble zinc compound, and (3) an organo-phosphorus acid compound or water soluble salt thereof.

In its decision dated February 7, 1986, the board affirmed the examiner's rejections under 35 U.S.C. § 103, finding that the claimed subject matter would have been obvious in view of various combinations of references, but with reliance primarily upon U.S. Patent No. 4,209,398 issued to Ii, et al. (Ii), U.S. Patent No. 4,374,733 issued to Snyder, et al. (Snyder '733) and U.S. Patent No. 4,255,259 issued to Hwa, et al. (Hwa).¹

The Ii patent discloses use in cooling water systems of scale and corrosion prevention compositions comprised of a polymeric component in combination with one or more compounds selected from the group consisting of inorganic phosphoric acids and water soluble salts thereof, phosphonic acids and water soluble salts thereof, organic phosphoric acid esters and water soluble salts thereof, and polyvalent metal salts. Although the Ii polymeric component may contain maleic acid and styrene monomers, there is no disclosure of the specific copolymer, SSMA, required in applicant's claims.

The Snyder '733 patent discloses a method for treating cooling water systems prone to scale formation by the addition of a composition comprised of an acrylic acid/lower alkyl/hydroxy acrylate copolymer and another polymeric component, which may be SSMA or a styrene/maleic anhydride (SMA) copolymer. The Snyder '733 patent notes that boiler and cooling water systems share a common problem in regard to scale deposit formation and that use of SMA to prevent scale in boiler water systems is known.

The Hwa patent is directed to a method for treating boiler water systems that are prone to scale formation by addition of a composition comprised of SSMA and an organo-phosphorus acid compound.

The remaining references, cited with respect to certain dependent claims, contain no suggestion to use SSMA, the specific copolymer recited in the appealed claims.

Based upon the prior art and the fact that each of the three components of the composi-

¹Hwa was cited only with respect to dependent claims 47 and 49.

tion used in the claimed method is conventionally employed in the art for treating cooling water systems, the board held that it would have been *prima facie* obvious, within the meaning of 35 U.S.C. § 103, to employ these components in combination for their known functions and to optimize the amount of each additive. The board further held that data appearing in appellant's specification, and supplemented by a declaration submitted pursuant to 37 C.F.R. § 1.132, provided insufficient evidence of nonobviousness to rebut the *prima facie* case.

Issues

1. Whether the board erred in finding that a prima facie case of obviousness was established.
 2. Assuming that a prima facie case of obviousness was established, whether the board erred in finding that appellant's objective evidence with regard to unexpected results was insufficient to rebut that prima facie case.

Analysis

Obviousness is a question of law based upon the factual inquiries mandated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), *Bausch & Lomb, Inc. v. Barnes-Hind/ Hydrocurve, Inc.*) 796 F.2d 443, 447, 230 USPQ 416, 419 (Fed. Cir. 1986). For a conclusion of obviousness, the standard of review is correctness or error as a matter of law. In re Caveney, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); In re DeBlauwe, 736 F.2d 699, 703, 222 USPQ 191, 195 (Fed. Cir. 1984).

[1] Appellant contends that the PTO failed to establish a prima facie case of obviousness and, consequently, that the board's affirmance of the examiner's rejections was erroneous. Appellant argues that the PTO's position represented hindsight reconstruction or, at best, established that it would have been "obvious to try" various combinations of known scale and corrosion prevention agents, including the combination recited in the appealed claims.

We agree with appellant that the PTO has failed to establish a prima facie case of obviousness. Obviousness cannot be established by combining the teachings of the

prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). We are convinced that the latter are not present here.

Li does not suggest use of SSMA as its claimed polymeric component and does not require the presence of an organophosphorus acid compound or of a zinc compound. Li notes that it is difficult to maintain a predetermined concentration of polyvalent metal ions, such as the zinc (II) ion, in alkaline cooling water, but states that its claimed polymeric component prevents the "polyvalent metals from becoming insoluble compounds and precipitating." Although Snyder '733 discloses use of SSMA, it is for the purpose of showing that it, or one of three other specifically recited copolymers, may be used in combination with yet another polymeric component, an acrylic acid/lower alkyl/hydroxy acrylate copolymer, to prevent scale formation. With respect to claims 47 and 49, Hwa does disclose the specifically recited organo-phosphorus acid compound. It provides, however, no suggestion to add a zinc compound to its disclosed combination of SSMA and organo-phosphorus acid compounds, or to use SSMA in combination with an organo-phosphorus acid compound in the treatment of a cooling water system, where the characteristics may significantly differ from those in Hwa's boiler water system. Hwa also provides no suggestion that SSMA could prevent precipitation of the zinc (II) ion in alkaline cooling water in the manner ascribed to the polymeric component of Li.

At best, in view of these disclosures, one skilled in the art might find it obvious to try various combinations of these known scale and corrosion prevention agents. However, this is not the standard of 35 U.S.C. § 103. *In re Goodwin*, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); *In re Tomlinson*, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Because we reverse on the basis of failure to establish a *prima facie* case of obviousness, we need not reach the issue of the sufficiency of the showing of unexpected results.

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The claims also recite a cooling water system containing (1) zinc ions, (2) styrene and maleic anhydride, (3) an organo-silicon three-part system, and (4) an inhibitor for the same. The applicant's system is a combination of (2) and (3) in the cooling water system. The Snyder '733 patent discloses a combination of (1) and (2) in cooling water systems. Hwang et al. (Hwang '626) discloses a combination of (1) and (3) in cooling water systems. It is known that zinc ions reduce the boiling point of water. It is also known that styrene and maleic anhydride in combination with an inhibitor results in boilover. It was known that zinc ions in combination with styrene and maleic anhydride inhibit the formation of scale in cooling water systems.

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The specific erosion/scale

Newman, Circuit Judge, concurring.

I agree in the court's result, but respectfully do not share the view that the PTO did not present a *prima facie* case that the claimed invention would have been obvious in terms of 35 U.S.C. § 103. I write separately because the determination of whether a *prima facie* case of obviousness has been made is a critical decision that controls the evidentiary procedures and burdens before the PTO.

The claims are directed to a three-component system to control scale and corrosion in cooling water systems, the components being (1) zinc ions, (2) a copolymer of sulfonated styrene and maleic anhydride (SSMA), and (3) an organophosphorus acid or salt. A three-part system is described in the Li reference for the same purpose, but differs from applicant's system in that the copolymer component (2) is different. There is no teaching of SSMA in the Li reference. However, the Snyder '733 reference teaches SSMA in combination with other polymers to control scale in cooling water systems. The use of SSMA in cooperation with phosphonate is known to reduce scale and sludge in boilers (Hwa). Hwa does not use zinc ions and it is known that zinc ions produce undesirable results in boilers, but the Li reference states that it was known to use zinc ions alone or in combination with organophosphorus acids or salts to inhibit corrosion in cooling water.

Thus each of Geiger's three components has been described, separately or in partial combination, for use in cooling water systems. In my view, it would have been *prima facie* obvious to replace the polymer component of Li with the known scale inhibitor SSMA, or to add an organophosphorus compound and zinc ions, both known corrosion inhibitors, to SSMA to achieve both scale and corrosion resistance in cooling water systems. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980); *Minnesota Mining & Manufacturing Co. v. An-sul Co.*, 213 USPQ 1024, 1033-34 (ED Wis. 1981). The Board so held.

The applicant, in rebuttal of the PTO's *prima facie* case, argued that his three component systems exhibits superior properties, and that the superiority was not obvious in view of the cited references. In support of this argument the applicant relied on experimental data in the specification.

The specification contains data on the corrosion/scale control capability of various

combinations of components, including data comparing the applicant's three-part system containing SSMA with other three-part systems containing other preferred scale-preventing polymers of the prior art. These data showed significant superiority of applicant's system; this was not disputed. The Board nevertheless held that the *prima facie* case was not rebutted because the applicant did not include data showing the properties of SSMA alone, stating that "the superior performance of such compositions may be due to the superiority of SSMA vis-a-vis the other scale-preventing copolymers."

I agree with the Board to the extent that it would have been of scientific interest to include such data. However, as a matter of law I believe that the applicant's showing was reasonable and sufficient. He complied with the requirement that the comparative showing "must be sufficient to permit a conclusion respecting the relative effectiveness of applicant's claimed compounds and the compounds of the closest prior art." *In re Payne*, 606 F.2d 303, 316, 203 USPQ 245, 256 (CCPA 1979), and must "provide an adequate basis to support a legal conclusion of unobviousness." *In re Johnson*, 747 F.2d 1456, 1461, 223 USPQ 1260, 1264 (Fed. Cir. 1984). The applicant demonstrated the exceptional corrosion inhibition achieved with his three-part system in comparison with systems containing the known corrosion inhibitors zinc ion and organophosphorus compounds. He also compared his combination with systems containing other known polymeric scale inhibitors such as those taught by Li, and demonstrated that those systems did not provide the improvement in corrosion and scale control achieved with the SSMA combination. He also demonstrated that neither polymaleic anhydride nor sulfonated polystyrene had the same effect on corrosion resistance as did the SSMA copolymer.

Applicant compared his system with the most relevant prior art. It is not required that the claimed invention be compared with subject matter that does not exist in the prior art. The applicant is not required to create prior art, nor to prove that his invention would have been obvious if the prior art were different than it actually was.

The Board also upheld the examiner's additional rejection that it would have been obvious to add zinc ion to the two-component SSMA/phosphonate system of Hwa. The Hwa system is for the reduction of scale and sludge at the high temperatures of steam

boilers, and it was uncontroverted that zinc ion is not usable at high temperatures. Applicant provided data showing that the Hwa system is relatively ineffective in a cooling system. The Board did not contradict this position on its scientific merits.

The applicant compared SSMA/phosphonate (Hwa) alone, SSMA/zinc, and phosphonate/zinc, with his three-component system, and achieved results that the Board held showed "superior performance." These results are sufficient in themselves to rebut a prima facie case of obviousness. See *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984).

Turning to the rejection on the breadth of the claim language, the limitations in the claims appear to be reasonably commensurate with the disclosure. Although I do not agree with the applicant that it is incumbent on the Commissioner to offer "technical evidence", applicant's specific examples are illustrative of the limitations described in the specification, and are not in themselves further limitations. *In re Johnson*, 558 F.2d 1008, 1017, 194 USPQ 187, 195 (CCPA 1977); *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Court of Appeals, Federal Circuit

S and T Manufacturing Co. v. County of Hillsborough, Florida

No. 86-1484

Decided March 31, 1987

JUDICIAL PRACTICE AND PROCEDURE

1. Procedure — Settlement agreements; consent decrees; waivers; releases (§410.43)

Federal district court did not err in finding that enforceable settlement agreement had been reached between patent infringement parties, despite plaintiff's argument that agreement was "agreement to agree" because no adequate drawing of noninfringing structure was prepared, since drawing at issue was initialed and referenced as showing acceptable noninfringing structure.

REMEDIES

2. Monetary remedies — Damages — In general (§510.0501)

Defendant in patent infringement suit is entitled to damages under Fed.R.App.P. 38.

BACKGROUND

This case arises out of a patent infringement dispute, concerning U.S. Patent No. 3,815,764. The parties with their counsel

2 USPQ2d

met in the trial judge's chambers on January 20, 1986, and discussion. A partial transcript of the proceedings reference a settlement agreement signed by the parties. During the meeting, a sketch made depicting a scene agreed upon would not be drawn. This informal drawing was referred to as the "Hillsborough pre-trial sketch." The transcript was presented to the court. S & T made a sketch and initialled it.

On March 4, 1991, attorney sent to S&T formal settlement agreement. On March 11, demands for modification document. originals of the proposed settlement document were sent to attorney. This document was S&T's March 11, 1991 motion to place the trial docket. In re a motion to enforce settlement agreement.

The district court denied S&T's motion, asserting that the minds at the February 20, 1998, meeting of disagreement.

The issue presented is whether the distribution agreement between the parties and thus voiding the entire agreement was erroneous.

**The jurisdiction
the complaint wa**

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